



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/975,672

10/10/2001

Norman F. Sheppard JR.

17509-0019

9452

29052

7590

06/21/2006

SUTHERLAND ASBILL & BRENNAN LLP  
999 PEACHTREE STREET, N.E.  
ATLANTA, GA 30309

EXAMINER

GRAY, PHILLIP A

ART UNIT

PAPER NUMBER

3767

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

C

<b>Office Action Summary</b>	<b>Application No.</b> 09/975,672	<b>Applicant(s)</b> SHEPPARD ET AL.	
	<b>Examiner</b> Phillip Gray	<b>Art Unit</b> 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 26-34, 36-39, 43, 56, 59 and 61-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-34, 36-39, 43, 56, 59 and 61-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/10/2006</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office Action is in response to Applicant's communication of 4/10/2006. Currently amended and new claims 26-34, 36-39, 43, 56, 59, 61-66 are pending and rejected in this action. Claims 1-25, 35, 40-42, 44-55, 57-58, 60 have been cancelled.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 26-39, 43, 52, 56-61 have been considered but are moot in view of the new ground(s) of rejections due to newly amended claims.

In response to applicant's arguments against the references individually, (i.e. remarks against Wise, Santini, Shawgo, McDevitt, Mickle), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 26-34, 36-39, 43, 56, 59, 61-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Santini et al. (U.S. Patent Number 6,123,861) in view of McDevitt (U.S. Patent Number 6,908,770), in further view of Mickle et al. (U.S. Patent Number 6,289,237). Santini patent discloses a multi reservoir device, which can be used for controlled release of chemical molecules, such as drugs. Further Santini discloses that the reservoir contents located in the reservoirs could include a sensor, specifically a biosensor, (see columns 8-11) and also that the control of exposure may be by a reservoir cap that may open by disintegrate to expose the reservoir contents, and measuring signals in vivo. McDevitt discloses a system for the rapid characterization of multi-analyte fluids, which includes a light source, a sensor array, and a detector. A series of chemically sensitive particles that may be configured to produce a signal when a receptor coupled to the particle interacts with the analyte. Using pattern recognition techniques, the analytes within a multi-analyte fluid may be characterized.

Santini in view of McDevitt discloses the claimed invention except for the telemetry system adapted to transmit data from a sensor to a remote control. Mickle et al teaches that it is known to use a telemetry system adapted to transmit data from a sensor to a remote control as set forth in column 7, line 58 to column 8, line 33 to provide dynamic real-time measurements to a base station. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the microchip drug delivery device as taught by Santini in view of McDevitt with a telemetry system adapted to transmit data from a sensor to a remote control as taught by Mickle et al., since such a modification would provide the microchip drug delivery device with a telemetry system adapted to transmit data from a sensor to a remote control for providing dynamic real-time measurements to a base station.

Claims 26-34, 36-39, 43, 56, 59, 61-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Santini et al. (U.S. Patent Number 5,797,898) in view of McDevitt (U.S. Patent Number 6,908,770), in further view of Mickle et al. (U.S. Patent Number 6,289,237). Santini patent discloses a multi reservoir device, which can be used for controlled release of chemical molecules, such as drugs. Further Santini discloses that the reservoir contents located in the reservoirs could include a sensor, specifically a biosensor, (see columns 8-11) and also that the control of exposure may be by a reservoir cap that may open by disintegrate to expose the reservoir contents, and measuring signals in vivo. McDevitt discloses a system for the rapid characterization of multi-analyte fluids, which includes a light source, a sensor array,

and a detector. A series of chemically sensitive particles that may be configured to produce a signal when a receptor coupled to the particle interacts with the analyte. Using pattern recognition techniques, the analytes within a multi-analyte fluid may be characterized.

Santini in view of McDevitt discloses the claimed invention except for the telemetry system adapted to transmit data from a sensor to a remote control. Mickle et al teaches that it is known to use a telemetry system adapted to transmit data from a sensor to a remote control as set forth in column 7, line 58 to column 8, line 33 to provide dynamic real-time measurements to a base station. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the microchip drug delivery device as taught by Santini in view of McDevitt with a telemetry system adapted to transmit data from a sensor to a remote control as taught by Mickle et al., since such a modification would provide the microchip drug delivery device with a telemetry system adapted to transmit data from a sensor to a remote control for providing dynamic real-time measurements to a base station.

Claims 26-34, 36-39, 43, 56, 59, 61-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wise et al. (U.S. Patent Number 5,989,445) in view of McDevitt (U.S. Patent Number 6,908,770), in further view of Mickle et al. (U.S. Patent Number 6,289,237). Wise discloses a multi reservoir device, which can be used for controlled release of chemical molecules, such as drugs. Further Wise discloses that the reservoir contents located in the reservoirs could include a sensor, and also that the control of

exposure may be by a reservoir cap that may open by a cutting (disintegrate) to expose the reservoir contents, and measuring signals in vivo. McDevitt discloses a system for the rapid characterization of multi-analyte fluids, which includes a light source, a sensor array, and a detector. A series of chemically sensitive particles that may be configured to produce a signal when a receptor coupled to the particle interacts with the analyte. Using pattern recognition techniques, the analytes within a multi-analyte fluid may be characterized.

Wise in view of McDevitt discloses the claimed invention except for the telemetry system adapted to transmit data from a sensor to a remote control. Mickle et al teaches that it is known to use a telemetry system adapted to transmit data from a sensor to a remote control as set forth in column 7, line 58 to column 8, line 33 to provide dynamic real-time measurements to a base station. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the microchip drug delivery device as taught by Wise in view of McDevitt, with a telemetry system adapted to transmit data from a sensor to a remote control as taught by Mickle et al., since such a modification would provide the microchip drug delivery device with a telemetry system adapted to transmit data from a sensor to a remote control for providing dynamic real-time measurements to a base station.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 3767

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gray whose telephone number is (571) 272-7180. The examiner can normally be reached on Monday through Friday, 8:30 a.m. to 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3767

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*PAG*

PAG

KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER

*Kevin C. Sirmons*